

UNITED STATES  
DEPARTMENT OF JUSTICE  
WASHINGTON, D.C. 20535

ROBERT MARRAS AND PORTER, INC.,

Plaintiffs,

WESTERN INSTRUMENTS, INC. and  
ALBERT EINSTEIN, INC.,

Defendants.

On Writ of Certiorari  
to the United States Court of Appeals  
for the Federal Circuit

IN SUPPORT OF PETITION FOR  
WRIT OF HABEAS CORPUS AND ASSOCIATION  
IN THE COURT OF RESPONDENTS

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No. 95-26

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IN THE  
**SUPREME COURT OF THE UNITED STATES**

OCTOBER TERM, 1995

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HERBERT MARKMAN and POSITEK, INC.,

*Petitioners,*

v.

WESTVIEW INSTRUMENTS, INC.  
and ALTHON ENTERPRISES, INC.,

*Respondents.*

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On Writ of Certiorari To The  
United States Court of Appeals for the Federal Circuit

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**AMICUS CURIAE BRIEF OF  
THE FEDERAL CIRCUIT BAR ASSOCIATION**

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**Statement of Interest of *Amicus Curiae***

The Federal Circuit Bar Association is a national organization comprising approximately 2,100 members from all areas who practice before the United States



Court of Appeals for the Federal Circuit in all aspects of its jurisdiction. The Association offers a forum for common concerns and dialog before the Bar and the Federal Circuit, government counsel and private practitioners, litigators, and corporate counsel. One of the main purposes of the Association is to offer assistance and advice to the Federal Circuit, including briefs *amicus curiae*, on matters affecting practice before the Federal Circuit and lower tribunals such as the Patent and Trademark Office and district courts whose decisions are reviewed by the Federal Circuit.

The Association submits this brief as *amicus curiae* in the hope that the Court will find it useful in deciding the issues to be reviewed in this matter. The Association hopes that this brief *amicus curiae* will demonstrate to the Court the practical benefits of the opinion below. In particular, the Association wishes to identify examples of the various situations which may arise in the litigation of patent claims for the consideration of the Court.

The views expressed in this brief are not necessarily those of its authors, their respective law firms, or their clients.

Letters of consent from the parties to the filing of this brief have been filed with the Clerk of the Court.

#### Summary of Argument

The Federal Circuit Bar Association submits this brief in support of the Respondents' position. The Federal Circuit's decision in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (*en*

*banc*) (hereinafter *Markman*), resolved a difficult problem: balancing the conflicting arguments supporting judge versus jury interpretation of patent claims. The *Markman* decision offers solutions to many of the questions which arise in the context of judicial interpretation of patent claims, and to the extent questions remain unanswered, they will be resolved by the developing body of case law after *Markman*.

If the Court should believe it necessary to provide guidelines to trial courts and patent practitioners to clarify the respective roles of judge and jury, the Association wishes to provide examples of situations that may arise needing clarification. Overall, however, the Association believes that the benefits of *Markman* outweigh any practical difficulties in implementing the decision.

In practice, patent litigation frequently leads to cases in which a genuine dispute arises in the interpretation of claim language, requiring the introduction and evaluation of extrinsic evidence, that is, evidence as to the meaning of claim terms which does not appear in the patent specification or in the text of material submitted to the Patent and Trademark Office as part of the prosecution history. The *Markman* decision recognizes the necessity of such extrinsic evidence, and authorizes its introduction and evaluation by the court during the task of claim interpretation. *Id.* at 979.

The Association is mindful of Supreme Court Rule 37.1, and thus will not address the historical Seventh Amendment arguments made by the respective

parties. Instead, the Association wishes to focus on practical issues which arise in the course of protecting the rights of patent holders. It is hoped that the issues set forth herein will emphasize the practical benefit of the judicial interpretation of patent claims, and will assist the Court in providing any guidance it deems necessary to implement the Federal Circuit's decision.

### Argument

#### I. Claim Interpretation Disputes Are Inevitable In Patent Litigation, And Some Of These Disputes Can Only Be Resolved By Relying Upon Extrinsic Evidence.

##### A. Inconsistencies within the patent specification or interpretation of terms of art in the claims may require extrinsic evidence, including expert testimony.

Numerous decisions of the Federal Circuit, including its decision in this matter, recognize the value of extrinsic evidence to ascertain the meaning of claims. *Markman*, 52 F.3d at 989. While it is clear that the claims, specification and prosecution history constitute an "undisputed public record" of proceedings in the Patent and Trademark Office, *id.*, at 980, it is likewise true that expert testimony is often helpful in resolving the meaning of disputed terms where those terms are not clear from the specification, prosecution history, or

other claims. See, e.g., *Advanced Cardiovascular Systems Inc. v. Scimed Life Systems Inc.*, 887 F.2d 1070, 1072-73 (Fed. Cir. 1989).

A first example is when the patent specification uses a term inconsistently in reference to more than one described structure. In the case of *Moeller v. Ionetics Inc.*, 794 F.2d 653 (Fed. Cir. 1986), the claim under interpretation utilized the term "electrode," but the patent specification "variously referred to both the electrode assembly and the sensitive tip of the electrode as 'the electrode'." *Id.* at 657. Further, one of the claims referred not only to an "electrode," but also to an "electrode system" and an "electrode body." Ionetics, the accused infringer, asserted that the use of the term "electrode" in the claim referred only to the ion-selective tip of its product, and not the entire length of the wire; the patent holder, Moeller, offered an expert declaration explaining that the term "electrode" is commonly used in three distinct senses. Clearly, in such a case, reference to the specification and prosecution history will provide little guidance to either the trial court or reviewing court as to what meaning of the term appearing in the specification should be adopted in construing the claim. Under those circumstances, it is only by resort to extrinsic evidence, and in particular, expert testimony, that the court can complete the first step of infringement analysis and resolve just what it is that the patentee owns.

Another instance may arise where reference solely to the documentary record would create an inconsistent result. Consider the situation presented in *Tillotson Ltd. v. Walbro Corp.*, 831 F.2d 1033 (Fed. Cir.



1987). In assessing a summary judgment motion on a reissued claim, the claim construction issue turned on whether the omission of the phrase "sole force" broadened or narrowed the reissued claim. The patent holder asserted a factual dispute as to whether atmospheric pressure in a chamber constituted a force acting within the chamber. During prosecution of the reissue patent, the Examiner originally rejected the proposed reissue claim, apparently using a zero baseline from which to measure pressure, meaning that the pressure in the chamber could never be "negative" (in other words, where a zero baseline is used, zero pressure in the chamber would constitute a vacuum, and the chamber could never contain less than a vacuum). Extrinsic evidence was submitted to show that industry practice would utilize atmospheric pressure as a base value, so that a pressure in the chamber below atmospheric pressure would be read as a negative pressure. Without resort to this evidence, the claim would have been inherently inconsistent.

Consider also a challenge to the validity of a patent under the enablement requirement of 35 U.S.C. § 112, paragraph 1. The statute specifically requires description of the invention in such "full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and use the same . . ." A typical challenge to enablement might occur where one skilled in the art would interpret a claim term differently than used in the patent. Arguably, the use of a term in a context different from the context known to one skilled in the art would disable, rather than enable, the skilled artisan from making and using the invention, rendering the patent

invalid. Extrinsic evidence concerning the usage of claim terms among those skilled in the art is useful in this circumstance.

Further, questions of the interpretation of claim terms might arise in the context of means-plus-function language under 35 U.S.C. § 112, paragraph 6. That paragraph was written "precisely to avoid a holding that a means-plus-function limitation be construed to cover only means disclosed in the specification." *DMI v. Deere and Co.*, 755 F.2d 1574 (Fed. Cir. 1985). A determination of the scope of equivalent structures will often necessarily include analysis of the claim terminology by reference to other means known to those who are skilled in the art.

Finally, consider the case of an accused infringer defending against a charge of willful infringement, who must explain to the jury the infringer's interpretation of a claim term in support of the contention that the infringer reasonably believed they did not infringe. Whether or not the offered claim interpretation is ultimately adopted by the court, expert testimony as to use of terminology in a particular industry, subject of course to cross-examination, could aid in the alleged infringer's defense. See generally *Goodwall Constr. Co. v. Beers Constr. Co.*, 824 F. Supp. 1044, 1051, 1057 (N.D. Ga. 1992), *aff'd in relevant part*, 991 F.2d 751, 756 (Fed. Cir. 1993) ("genuine evidentiary dispute" supported by record evidence related to proper interpretation of terms "riveter", "blunt-tipped moil point rod" and "secured forced pressure" in claims).

**B. *Markman* acknowledges that extrinsic evidence is necessary.**

The majority opinion below acknowledges that extrinsic evidence "may be helpful to explain scientific principles, the meaning of technical terms, and terms of art that appear- in the patent and prosecution history," explaining that "[a] judge is not usually a person conversant in the particular technical art involved and is not the hypothetical person skilled in the art to whom a patent is addressed." *Markman*, 52 F.3d at 981, 986. The majority asserts that:

[in] using certain extrinsic evidence that the court finds helpful and rejecting other evidence as unhelpful, and resolving disputes en route to pronouncing the meaning of claim language as a matter of law based on the patent documents themselves, the court is not crediting certain evidence over other evidence or making factual evidentiary findings. Rather, the court is looking to the extrinsic evidence to assist in its construction of the written document, a task it is required to perform.— The district court's claim construction, enlightened by such extrinsic evidence as may be helpful, is still based upon the patent and prosecution history. It is therefore still construction, and is a matter of law subject to de novo review.

*Markman*, 52 F.3d at 981 (emphasis added) (footnote omitted).

**II. Issues Arising Under *Markman* and Their Practical Consequences**

*Markman* not only clarified the roles of judge and jury in a patent infringement action, it will also have a significant effect on the courtroom procedures and options for a patent holder at the district court level. Trial procedures for patent cases adopted by this Court must be procedurally workable and fair in order to protect the rights of all patent holders and patent infringers. The following issues should therefore be considered when providing guidance to the lower courts on claim interpretation.

**A. Patent holders and accused infringers should be able to ascertain the scope of a patent's claims.**

A function of the claims in a patent is to inform the public of the rights and scope of the invention claimed by the inventor. As the Federal Circuit noted in *Markman*, "it is only fair (and statutorily required) that competitors be able to ascertain to a reasonable degree the scope of the patentee's right to exclude." *Markman*, 52 F.3d at 978 (citing *Merrill v. Yeomans*, 94 U.S. 568 (1877)); see also *McClain v. Ortmyer*, 141 U.S. 419, 424 (1891) ("The object . . . is not only to secure to [the patentee] all to which he is entitled, but to apprise the public of what is still open to them."). The primary purpose of this requirement is to provide clear warning to others as to what constitutes infringement of the patent. At the same time, a patent is not to unduly inhibit experimentation and further advances in the



field. "A zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field." *United Carbon Co. v. Binney Co.*, 317 U.S. 228, 236 (1942).

A second function of the claims is to apprise the inventor of the scope of the invention in which the inventor has rights. The inventor should be able to reasonably interpret the scope of the claims without resort to constant litigation. As this Court has noted, it is a benefit to the patentee to be able to arrive at a true and consistent scope of the claims. "The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public." *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938).

Prior to *Markman*, a patent holder involved in multiple lawsuits risked inconsistent jury verdicts when a jury was allowed to apply different interpretations to the claims of a patent. Although the jury verdict could be appealed, under the clearly erroneous standard applied by an appellate court in its review of jury claim interpretation findings, inconsistent claim interpretations could result. A patent holder therefore faced uncertain litigation outcomes while litigating the same patent.

In *Markman*, the Federal Circuit recognized a patentholder's fear of inconsistent jury verdicts. As noted by the court:

To treat the nature of the patented invention as a matter of fact, to be inquired of and determined by a jury, would it once deprive the inventor of the opportunity to obtain a permanent and universal definition of his rights under the patent, and in each case of infringement it would subject him to the danger of false interpretation, from the consequences of which he could not escape. By confiding this duty to the court, however, its decision as to the nature of the patented invention becomes reviewable to the same extent as any other legal question, and when his patent has received the interpretation of the Supreme Court of the United States the inventor can maintain his privilege, as thus interpreted, against all opponents without further controversy in reference to its true limitations.

*Markman*, 52 F.3d at 979 (citing 2 WILLIAM C. ROBINSON, THE LAW OF PATENTS FOR USEFUL INVENTIONS § 733 (1890)). To ensure that a patent holder is able to obtain a clear and universal definition of their rights under a patent, claim interpretation was held to be a matter of law. *Markman*, 52 F.3d at 979. The *de novo* review provided for by *Markman* will provide more uniformity to patent holders.

Amicus believe that the benefits provided to patent holders by the *de novo* review of claim interpretation outweigh any practical difficulties that critics have suggested will arise in implementing

*Markman*. The Federal Circuit decision should therefore be affirmed. At the same time, however, *de novo* review raises several issues about trial practice for patent holders and the appropriate role of judge and jury in collateral interpretation matters. As set forth below, the existence of these issues should not suggest that *Markman* is unworkable. Instead, these issues are presented to assist the Court should the Court deem it necessary to provide further guidance in implementing the *Markman* decision.

Under *Markman*, more consistent interpretations may result in cases where a patent holder sues multiple parties under the same patent. However, *de novo* review may place additional pressure on the patent holder during the district court trial. With a *de novo* review of claim interpretations, a patent holder could be required to present sufficient evidence to support several alternate claim interpretations at the district court level. The consequences of not presenting alternative evidence at trial, and the potential effect on the patentee, is aptly demonstrated by the case *Exxon Chemical Patents Inc. v. Lubrizol Corp.*, 64 F.3d 1553 (Fed. Cir. 1995). In *Exxon*, Exxon presented at the district court level one interpretation of a claim directed to a patented lubricating oil composition. Lubrizol presented and argued a second conflicting interpretation. The trial judge selected Exxon's interpretation, and charged the jury according to Exxon's construction. The jury found that the patent was not invalid under 35 U.S.C. § 102 or § 103, and that Lubrizol had willfully infringed the claims of the patent. Attorneys' fees and costs were awarded to Exxon, an injunction was entered against

Lubrizol, and a damage award was entered in a separate proceeding.

In its *de novo* review of the trial judge's selection of Exxon's preferred claim interpretation, the Federal Circuit determined that Exxon's claim interpretation was incorrect, and that Lubrizol's was only partly correct. *Id.* at 1555. The Federal Circuit also found that under a jury charge stating the correct interpretation of the claims, "no jury could reasonably have found—on the evidence submitted by Exxon—that Lubrizol's accused products literally infringed Exxon's claims." *Id.* Because of Exxon's failure of proof, Lubrizol was granted judgment as a matter of law without remand. The Federal Circuit therefore vacated the order awarding attorneys' fees, costs, and the injunction against Lubrizol.

As noted by Judge Nies in the dissent, "by advocating a different interpretation of the claim *sua sponte*, the majority required Exxon to litigate during trial not only its opponent's position but also the unknowable position of the appellate court." *Id.* at 1569. By requiring a patent holder to litigate several permutations of a claim at a district court level, the Federal Circuit may have increased the introduction of evidence at trial. *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1520–21 (Fed. Cir. 1995), *petition for cert. filed*, (U.S. Nov. 6, 1995) (No. 95-728). While consistency will therefore improve under *Markman*, the burden on a patent holder to present additional theories and expand the evidence presented at trial may have increased.



**B. Court and jury roles should be clarified in a challenge to patent validity under 35 U.S.C. § 112, paragraph 2.**

*Markman* raises practical concerns in determining patent validity based on claim indefiniteness under 35 U.S.C. § 112, paragraph 2. The standard for a determination of patent validity based on claim indefiniteness is whether a claim reasonably apprises those skilled in the art of the scope of the invention. The decision below presupposes that there is no ambiguity in the claim language to a person of ordinary skill in the art that would require resort to evidence outside of the specification and prosecution history. Although the decision notes that ambiguity and vagueness in claim language go to claim validity based on indefiniteness and not to claim construction, issues of claim indefiniteness are intertwined with claim construction.

In patent infringement litigation there is often a factual dispute. When disputes as to the meaning and scope of the technical terms or words of art arise in the context of claim construction, its resolution is a ruling of law. However, when such disputes arise in the context of claim validity based on indefiniteness, its resolution is typically based on a findings of fact. See, e.g., *Hoffman-LaRoche, Inc. v. Burroughs Wellcome Co.*, 10 U.S.P.Q.2d 1602, 1607 (D. Md. 1989) (dispute as to which meaning of the term "homogenous" was intended by the patentee raises factual issues in a determination of indefiniteness). The Federal Circuit recently held in *In re Lockwood*, 50 F.3d 966 (Fed. Cir. 1995) that the issue of validity must be given to the jury as a matter of

constitutional right. This disparate treatment of disputes as to the meaning of claim terms depending on the context raised has not yet been resolved.

**C. Court and jury roles should be clarified in a challenge to patent validity requiring a determination of the level of skill of one "skilled in the art".**

The focus of the inquiry in construing disputed terms in patent claim language is on what one of ordinary skill in the relevant art at the time of the invention would have understood the disputed terms to mean in view of the claims, specification, and prosecution history. *Markman*, 52 F.3d at 986; *Pall*, 66 F.3d at 1224 (Mayer, J., concurring).

That inquiry is similar to the validity inquiry into nonobviousness under 35 U.S.C. § 103, which provides, in pertinent part, that a patent may not be obtained

if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

This Court has characterized the obviousness inquiry as one of law that "lends itself to several basic factual inquiries" including the scope and content of the prior art; the differences between the prior art and the claims at issue; and the level of ordinary skill in the pertinent art. *Graham v. John Deere Co.*, 383 U.S. 1,



17 (1966). In *Dennison Manufacturing Co. v. Panduit Corp.*, 475 U.S. 809, 811 (1986), the Court explained that the subsidiary inquiries that must be made under the test for nonobviousness are factual in nature and are to be reviewed on appeal under the clearly erroneous standard. Thus, this Court may wish to address whether the determination of what one of ordinary skill in the relevant art at the time of the invention would have understood disputed claim terms to mean subsumes the *Graham* determination of the level of ordinary skill in the relevant art.

**D. *Markman's* effect on patent trial procedure should be considered.**

The interpretation of claim language often determines the outcome of litigation. Patent holders typically argue one interpretation of the claim, and alleged infringers another. Selecting between the two interpretations, or creating a third interpretation, can foreclose a fact finder's decision when applying the facts of the case to the selected claim construction.

Because of the importance of the claim interpretation process, several courts have noted the changes in trial procedure that may arise if a judge must interpret the claim before instructing a jury. First, *Markman* may require additional furcation of a typical patent infringement lawsuit. As Judge Newman noted in her dissent, *Markman* may require a "mini-trial" or other evidentiary hearing in order for a judge to learn sufficient information about the claim language to decide the disputed issues. *Markman*, 52 F.3d at 1008 n.5. The addition of a mini-trial to hear evidence solely

directed to claim interpretation should provide the judge with sufficient information to make the often difficult determination between competing claim interpretations.

It has been recognized that it is advantageous to decide all claims and issues in a civil action within one trial. *Lis v. Robert Packer Hosp.*, 579 F.2d 819 (3d Cir.), *cert. denied*, 439 U.S. 955 (1978). Because of increasing court caseloads, and the limited time for scheduling and hearing trials, the efficient resolution of civil matters demands that as many issues as possible be decided within the span of one trial. The addition of mini-trials would add an additional break in a typical patent infringement action.

It should be noted, however, that such furcations are not new to patent infringement actions. The rules provide that under certain circumstances claims or issues may be separated for separate trials if it is in the interest of efficient judicial administration. FED. R. CIV. P. 42(b). In particular, it has become commonplace for patent cases to be bifurcated (if not trifurcated) into separate phases. *See Gardco Mfg., Inc. v. Herst Lighting Co.*, 820 F.2d 1209, 1212 (Fed. Cir. 1987) ("Under Rule 42(b), a district court has broad discretion in separating issues and claims for trial as part of its wide discretion in trial management.") Typically one phase is directed to liability, and one phase is directed to damages. An additional furcation of a patent lawsuit would therefore not introduce new procedures into a patent infringement action.

A second procedural change suggested by *Markman* is the practical problem of providing a district

court adequate time to fairly rule on claim interpretation issues while the jury waits for instruction. As noted by Judge Schwartz in *Lucas Aerospace, Ltd. v. Unison Industries, L.P.*, 890 F. Supp. 329 (D. Del. 1995):

To construe the claims before giving the case to the jury requires immediate access to a trial manuscript, i.e., daily copy which creates a not insignificant expense to the parties, . . . rapid briefing by the parties, and hopefully an opinion by the court. In this case, it would probably have taken no less than five days for the parties to file helpful briefs and the court to memorialize its holdings on claim construction in a meaningful manner. If the jury were sent home during this period, there is a very real chance that many of the facts important to resolving the infringement issues will have been forgotten.

*Id.* at 332 n.3.

Mitigating any delay caused by claim interpretation is the ability of courts to rule on claim interpretation issues prior to trial. Appropriate use of pre-trial motions may actually shorten patent trials by resolving claim interpretation issues prior to the presentation to the jury of remaining factual issues.

### Conclusion

The Federal Circuit Bar Association respectfully urges affirmation of the decision below. The *Markman* decision provides a workable resolution of the challenge

of balancing judge and jury roles in patent litigation, and will benefit patent holders and accused infringers alike. Subsequent decisions of the Federal Circuit will provide

guidance to judges and practitioners in the resolution of the issues raised herein.

Respectfully submitted,

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